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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/625,967	07/26/2000	Naoyuki Inoue	000929	8413

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ARMSTRONG, WESTERMAN & HATTORI, LLP  
1725 K STREET, NW.  
SUITE 1000  
WASHINGTON, DC 20006

EXAMINER

SORRELL, ERON J

ART UNIT	PAPER NUMBER
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2182

DATE MAILED: 12/24/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/625,967

Applicant(s)

INOUE, NAOYUKI

Examiner

Eron J Sorrell

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 July 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

1. Claims 1-16 have been examined.

***Information Disclosure Statement***

2. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this

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application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4. Claims 1-3,5,11,13 and 16 are rejected under 35 U.S.C. 102(e) as being anticipated by Ozawa et al. (U.S. Patent No. 5,870,710 hereafter referred to as Ozawa).

5. Referring to claim 1, Ozawa discloses an expansion device having a main body provided with a mounting portion, in which a readout device is mountable and enabled to read information processing data from a storage medium storing the information processing data and to read sound reproducing data, the expansion device being connected to a host device and used for transmission of data between the host device and the data readout device, the expansion device comprising:

audio circuits for processing the sound reproducing data (see items labeled 46, 52, and, 56 in figure 7);

a first power input portion for being supplied with source power for the expansion device from a power supply for the host device (see item labeled 62 in figure 7 and the associated connections);

a second power input portion for being supplied with source power for the expansion device from a second power supply other

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that the power supply for the host device (see item labeled 53 in figure 7);

wherein operations of the audio circuit and the readout device are enabled by supplying source power thereto from the second power input portion when no source power is supplied to the first power input portion (see lines 38-45 of column 7).

6. Referring to claim 2, Ozawa discloses the operating portion for controlling an operation of the readout device is provided in the main body (see item labeled 41 in figure 7).

7. Referring to claim 3, Ozawa discloses the mounting portion is adapted to selectively and detachably accommodate a plurality of kinds of expansion units other than the readout device (see figures 9A-9F and lines 45-60 of column 8).

8. Referring to claim 5, Ozawa discloses that the second power supply is a battery built thereinto (see item labeled 53 in figure 7).

9. Referring to claim 11, Ozawa discloses the battery is a chargeable battery (see lines 14-17 of column 5).

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10. Referring to claim 13, Ozawa discloses the host device is connected to the expansion device by connecting a connector provided in the host directly to a connector provided on the expansion device (see lines 1-9 of column 5).

11. Referring to claim 16, Ozawa discloses the second power input portion is provided in the first input portion (see items labeled 53 and 62 in figure 7 and the associated connections).

***Claim Rejections - 35 USC § 103***

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

13. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ozawa et al.

14. Referring to claim 8, Ozawa fails to explicitly disclose that the battery voltage is lower than then the first power supply, however, Ozawa discloses the first power input portion

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is a common power outlet on a wall, which has an output voltage of 110 volts. Batteries for use in digital systems have an output of no more than 5 volts because that is the maximum voltage required in most digital systems, hence it would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to modify the device such that the battery voltage is lower than then the first power supply voltage.

15. Claims 4,7,9,10, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ozawa et al. in view of Flannery (U.S. Patent No. 6,424,796).

16. Referring to claim 4, Ozawa fails to disclose the second power supply being an external DC power supply.

Flannery discloses an expansion device wherein a second power supply is an external DC power supply (see item labeled 420 in figure 6).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to modify the device of Ozawa with the device of Flannery such that the second power supply is an external DC power supply. One of ordinary skill in the art would have been motivated to make the

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modification so a replacement DC power supply can be used if the current DC power supply becomes non-functional.

17. Referring to claim 7, Ozawa fails to disclose the plurality expansion units are a CD-ROM drive, a floppy disk drive, a DVD drive, a memory card drive, and a hard disk drive.

Flannery discloses a device wherein a plurality of expansion units are a CD-ROM drive, a floppy disk drive, a DVD drive, a memory card drive, and a hard disk drive (see lines 65-67 of column 2 and lines 1-15 of column 3).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention such that the plurality expansion units are a CD-ROM drive, a floppy disk drive, a DVD drive, a memory card drive, and a hard disk drive. Flannery suggests this is desirable because this allows older disk drives to still be used if the owner buys a newer drive for their personal computer (see lines 9-49 of column 1 in Flannery).

18. Referring to claim 9, Flannery discloses the CD-ROM drive has both a decoding circuit for decoding digital data and a decoding circuit for decoding analog data and wherein switching between a digital data signal and an analog music signal is



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automatically performed according to the kind of the storage medium (see items labeled 310, 312, and 318 in figure 5 and 34-67 of column and lines 1-8 in column 5).

19. Referring to claim 10, Flannery discloses the readout device indicates a playing track number and a piece number in a display device of the operating portion when the storage medium is an audio disk (see item labeled 210 in figure 4A).

20. Referring to claim 14, Flannery discloses a connector is installed in the mounting portion provided in the main body, wherein a corresponding connector is provided in the readout device, and wherein the readout device is connected to the main body only by inserting the readout device into the mounting portion (see lines 16-37 of column 3).

21. Claims 6, 12, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ozawa in view of Flannery as applied to claims 4, 7, and 14 above, and further in view of Gilbert (U.S. Patent No. 6,357,011).

22. Referring to claim 6, both Ozawa and Flannery fail to disclose the host device being notebook personal computer.

Gilbert discloses a system with first and second power input sources wherein the host system is a personal computer. Gilbert does not explicitly disclose the PC being a notebook, however notebook PC's are common in the art and would have all of the elements the PC labeled 20 in figure 1.

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to further modify the device of Ozawa with the device of Gilbert such that the host device is notebook PC. One of ordinary skill in the art at the time of the applicant's invention would have been motivated to make the modification so the expansion device can be used with a computer as suggested by Gilbert.

23. Referring to claim 12, Gilbert discloses that the host device is connected to the expansion device by a cable (see item labeled 30 in figure 1).

18. Referring to claim 15, Gilbert discloses that the cable is detachable from the host device (see lines 46-52 of column 2).

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Applicant is reminded that

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in amending in response to a rejection of claims, the patentable novelty must be clearly shown in view of the state of the art disclosed by the references cited and the objections made. Applicant must also show how the amendments avoid such references and objections. See 37 CFR § 1.111(c).

The following U.S. Patents have been cited to further show the state of the art as it pertains to expansion devices:

U.S. Patent No. 6,480,909 to Chun

U.S. Patent No. 5,132,947 to Kameda et al.

U.S. Patent No. 6,128,263 to Fujii et al.

U.S. Patent No. 5,698,834 to Worthington et al.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eron J Sorrell whose telephone number is 703 305-7800. The examiner can normally be reached on Monday-Friday 9:00AM - 5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffery A Gaffin can be reached on 703 308-3301. The fax phone numbers for the organization where this application or proceeding is assigned are 703 746-7239 for regular communications and 703 746-7238 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 305-3900.

EJS  
December 20, 2002



JEFFREY GAFFIN  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100